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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,790	08/27/2003	Clark Easter	026063-00014	4489
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ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER NGUYEN, MAIKHANH	
			ART UNIT 2176	PAPER NUMBER
			NOTIFICATION DATE 09/21/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com  
IPMatters@arentfox.com  
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## Office Action Summary

Application No.

10/648,790

Applicant(s)

EASTER ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. This action is responsive to the amendment filed 07/02/2007 to the original application filed 08/27/2003.

Claims 1-33 are pending for examination. Claims 1 and 21-22 are independent claims.

## Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

Claim 33 remains rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claim is directed to a signal directly or indirectly by claiming *a computer usable medium* and the Specification (see ¶ 0058) recites evidence where the medium is defined as a “*signals*” (such as signal bearing media, transmission-type media, light wave transmissions). In that event, the claim is directed to a form of energy which at

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present the office feels does not fall within at least one of the four enumerated categories of patentable subject matter recited in section 101. See MPEP 2106.01.

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

*This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Roper** (US 6270351) in view of **Cornelius et al.** (US 7069234 B1).

#### **As to claim 1:**

Roper teaches a method for providing interactive assistance with populating an automated document that includes at least one field (*see the Abstract & col. 2, lines 1-35*), the method comprising:

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- selecting an entity to which the document applies (*col.2, lines 1-44 & col.4, lines 32-44*);
- assigning a prioritization to each of the at least one field (*e.g., when a user logs onto the individual education program system, he must enter a login ID and password; col. 8, lines 15-29 & see item StudentID in fig.5*);
- prompting for a response for each of the at least one field (*e.g., Once the student profile is generated ... prompting the user of the system for certain basic information regarding the student ... includes the student's name, age, birthdate, grade, etc...; col. 6, lines 10-18 & see fig. 7*), the prompting varying based on the prioritization of each of the at least one field (*col.6, lines 1-21*);
- iteratively revising the prioritization of all of the at least one field upon receiving the response to each of the at least one field (*e.g., the system automatically brings up the student's current IEP record ... The next step in the process for editing an existing individual education plan comprises displaying the student's information screen for the current individual education plan on the computer monitor ... Changes in the student information may be made on this screen by the users of the system*) [*see the discussion beginning at col.7, line 30*]; and

- prompting for a response for at least one field, the prompting varying based on the iteratively revised prioritization of all of the at least one field (*e.g., before an individual education plan may be created, a student profile is created by entering information about the student. The user of the system selects the Enter/Edit Student information option 402 from the main menu 400. Selecting this option brings up a student information screen. Via the student information screen, the user of the system may enter all pertinent information relating to the particular student... records are saved, the individual education program tracking system returns control to the main menu 400... Typically, a state has requirements that must be met before a student can enter a special education plan, such as that provided by an individual education plan. These requirements include an assessment of a student's skills and parental (guardian) authorization. The individual education program tracking system automatically generates the forms for complying with these regulatory requirements. Once the requirements have been met, then an individual education plan may be created for a student*) [see the discussion beginning at col.8, line 15].

Roper, however, does not specifically teach performing a compliance check for each response for the at least one field.

Cornelius teaches performing a compliance check for each response for the at least one field (*e.g., The compliance checking is performed through data validation on defined*

*parameters of structured formats for text. Once the compliance engine finds all structured fields/tag are in compliance (clean), an automatic signal is sent to the bank/buyer for payment authorization. When payment authorization is received, the signal will prompt Visanet to credit the seller's account. Anytime the value of the data falls outside the parameter of the structured field, it is rejected as 'discrepant.' The rejection will be automatically sent and highlighted to both buyer and seller electronically. Only upon the completion of all checks of structured fields will discrepancy signal be sent to buyer and seller, who will renegotiate on the highlighted discrepancies on VTrade Web's electronic platform; col.23, lines 15-63).*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Roper with Cornelius because Cornelius' teaching would have greatly increased the speed in obtaining and completing the forms necessary to create and administer the plans, and greatly increased the efficiency of the analysis of the data compiled.

**As to claim 2:**

Roper teaches the document is a form (*e.g., form; col.5, lines 20-25*).

**As to claim 3:**

Roper teaches the form is used for compliance with educational requirements (*e.g., forms required by either or both local school districts and state departments of education; col.2, lines 26-30*).

**As to claim 4:**

Roper teaches the educational requirements include requirements under the Individuals with Disabilities Education Act (*col.1, lines 16-34*).

**As to claim 5:**

Roper teaches identifying data from an accessible repository responsive to any of the at least one field of the document (*see item StudentID in fig.5*); and automatically populating each of the at least one field of the document for which the responsive data from the accessible repository are identified (*col.9, lines 1-46 and see fig.9*).

**As to claim 6:**

Refer to the discussion of claim 1 above for rejection of “*performing a legal compliance check of a response for the at least one field*”.

**As to claim 7:**

Roper, however, does not specifically teach if the compliance check passes, providing an option to lock the document.

Cornelius teaches if the compliance check passes, providing an option to lock the document (*see col.23, lines 15-63 and col.67, lines 15-64*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Roper with Cornelius because Cornelius' teaching would have greatly increased the speed in obtaining and completing the forms necessary to create and administer the plans, and greatly increased the efficiency of the analysis of the data compiled.

**As to claim 8:**

Roper teaches receiving a selection of a response to the option to lock the document; and if the selection is to lock the document, preventing revision of each of the responses to the at least one field (*e.g., If the user selects the Lock This IEP option 1710, the system locks the individual education plan record in the individual education program database 18 from any further modifications; col.13, lines 1-13 and see fig.1*).

**As to claim 9:**

Roper teaches prompting a user for security information (*e.g., enter a login ID and password; col.7, lines 15-16*).

**As to claim 10:**

Roper teaches the entity is an individual (*e.g., an individual; see the Abstract*).

**As to claim 11:**

Roper teaches storing the automated document with the response to each of the at least one field (*see figs. 9-11 and associated text*).

**As to claim 12:**

Roper teaches prompting for a response to each of the at least one field includes: variably highlighting each of the at least one field (*see figs. 7-8 and associated text*).

**As to claim 13:**

Roper teaches variably highlighting each of the at least one field includes: highlighting each of the at least one field in a color, the color varying with the prioritization of each of the at least one field (*see figs. 7-8 and associated text*).

**As to claim 14:**

Roper teaches identifying data from an accessible repository responsive to any of the at least one field of the document (*see item StudentID in fig.5*); and automatically populating each of the at least one field of the document for which the responsive data from the accessible repository are identified (*col.9, lines 1-46 and see fig.9*); and highlighting each of the at least one field containing automatic populating (*see figs. 7-8*).

**As to claim 15:**

Roper teaches prompting for a response to one field is selected from, among other things, prompting for an optional response (*e.g., selection of the Enter/Edit Student Information of the main menu; col.6, lines 1-42 & col.7, line 60-col.8, line 14*).

**As to claim 16:**

Roper teaches selecting an entity to which the document applies includes searching a repository containing at least one entity (*col.6, lines 22-58 and see fig.1*).

**As to claim 17:**

Roper teaches providing an option to select the automated document form a plurality of documents (*col.6, lines 1-42 & col.7, line 60-col.8, line 14*).

**As to claim 18:**

Roper teaches generating the plurality of documents via a search (*col.5, line 59-col.6, line 58*).

**As to claim 19:**

Roper teaches the automated document is associated with a meeting (*col.9, line 47-col.10, line 7 and see fig.12*).

**As to claim 20:**

Roper teaches the meeting includes at least one event (*col.9, line 47-col.10, line 7 and see fig.12*).

**As to claim 21:**

It is directed to a system for performing the method of claim 1 above, and is similarly rejected under the same rationale.

**As to claim 22:**

The rejection of claim 21 above is incorporated herein in full. Additionally, Roper teaches a processor (*e.g., computers*); a user interface (*e.g., a user-friendly interface; col.4, line 20*); and a repository (*e.g., a central database*) [*see col.2, lines 54-63 and col.4, lines 1-53*].

**As to claim 23:**

Roper teaches the processor is housed on a terminal (*e.g., a personal computer; col.4, lines 4-5*).

**As to claim 24:**

Roper teaches the terminal is selected from, among other things, a personal computer (*e.g., a personal computer; col.4, lines 4-5*).

**As to claim 25:**

Roper teaches the processor is housed on a server (*e.g., the server 10; col.4, line 3 and see fig.1*).

**As to claim 26:**

Roper teaches the server is selected from, among other things, a personal computer (*e.g., a personal computer; col.4, lines 4-5*).

**As to claim 27:**

Roper teaches the server is coupled to a network (*e.g., the network; col.4, lines 5-16 and see fig.1*).

**As to claim 28:**

The use of the Internet is inherent to the system of Roper.

**As to claim 29:**

Roper teaches the server is coupled to the network via a coupling (*col.4, lines 3-16*).

**As to claim 30:**

Roper teaches the coupling is selected from a group consisting of a wired connection, a wireless connection, and a fiberoptic connection (*e.g., see fig.1 and the accompanying text beginning at col.3, line 63*).

**As to claim 31:**

Roper teaches the repository is housed on a server (*e.g., the server 10; col.4, line 3 and see fig.1*).

**As to claim 32:**

Refer to the discussion of claim 27 above for rejection.

## **Response to Arguments**

4. Applicant's arguments with respect to claims 1-33 have been fully considered but they are not persuasive.

### **A. Regarding the 35 USC § 101 rejections**

Applicant argues in substance that claim 33 is directed to statutory subject matter.

In response, the claim is not narrowed to exclude transmission-type media. Therefore, it is not statutory. See MPEP 2106.01.

### **B. Regarding the 35 USC § 102 (e) rejections**

#### **(i) Regarding independent claims 1, 21, 22, and 33**

Applicant argues in substance that Roper does not teach performing a compliance check for each response for the at least one field.

In response, the newly cited reference, Cornelius, teaches performing a compliance check for each response for the at least one field (*e.g., The compliance checking is performed through data validation on defined parameters of structured formats for text. Once the compliance engine finds all structured fields/tag are in compliance (clean), an automatic signal is sent to the bank/buyer for payment authorization. When payment authorization is received, the signal will prompt Visanet to credit the seller's account. Anytime the*

*value of the data falls outside the parameter of the structured field, it is rejected as 'discrepant.' The rejection will be automatically sent and highlighted to both buyer and seller electronically. Only upon the completion of all checks of structured fields will discrepancy signal be sent to buyer and seller, who will renegotiate on the highlighted discrepancies on VTrade Web's electronic platform; col.23, lines 15-63).*

**(ii) Regarding dependent claims 2-20 and 23-32**

Applicant did not provide arguments in substance regarding claims 2-20 and 23-32 except for citing the dependencies.

**Conclusion**

5. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

**Contact information**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30

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pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**  
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